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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,009	01/21/2002	Ross Saunders	2545-000013	5489
27572	7590	11/01/2005		
HARNESSE, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
			EXAMINER BELLO, AGUSTIN	
			ART UNIT 2633	PAPER NUMBER

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/054,009

Applicant(s)

SAUNDERS ET AL.

Examiner

Agustin Bello

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-31 and 33-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7,9-31 and 33-36 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9-10, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards (U.S. Patent No. 6,778,778).

Regarding claim 1 and 21, Richards teaches a network diagnostic system for an optical transport network having a plurality of network elements, comprising, a first network element (reference numeral 12, 20, 38 in Figure 1) residing in the optical transport network (reference numeral 10 in Figure 1), the first network element having a network diagnostic operation integrated therein (reference numeral 12, 38 in Figure 1) and operable to perform the network diagnostic operation, wherein the network diagnostic operation directly monitors an optical signal traversing the optical transport network (e.g. "test signal" throughout), a network diagnostic device (reference numeral 62 in Figure 1) in data communication with a second network element (reference numeral 24 in Figure 1) residing in the optical transport network (reference numeral 10 in Figure 1) and operable to initiate the network diagnostic operation at the first network element; the second network element (reference numeral 24 in Figure 1) adapted to receive a request to initiate the network diagnostic operation from the network diagnostic device (reference numeral 62 in Figure 1), the second element (reference numeral 24

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in Figure 1) operable to map the request into at least one optical network frame (column 6 lines 48-61) and transmit the optical network frame over an optical supervisory channel (e.g. by virtue of the OSS nature of element 24 in Figure 1; column 5 lines 24-31) of the optical transport network to the first network element (reference numeral 12, 38, 20 in Figure 1).

Regarding claim 2, Richards teaches that the network element is further operable to communicate the network performance data determined by the network diagnostic operation to the network diagnostic device (column 5 lines 40-41).

Regarding claim 3, Richards teaches that the network diagnostic device is operable to display the network performance data received from the first network element (via computer 62 in Figure 1).

Regarding claim 4, Richards teaches that the network diagnostic device (reference numeral 62 in Figure 1) is directly connected to the second network element (reference numeral 24 in Figure 1).

Regarding claim 5, Richards teaches that the network diagnostic device is connected via a computer network (reference numeral 24 in Figure 1) to the second network element.

Regarding claim 6, Richards teaches that the second network element is further operable to communicate in real-time the network performance data determined by the network diagnostic operation to the network diagnostic device using TLI network management protocol (inherent in the ongoing machine to machine communication).

Regarding claim 9, Richards teaches that the second network element is adapted to receive Ethernet frames from the network diagnostic device, where the Ethernet frames embody a request to initiate the network diagnostic operation; the second network element being further

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operable to map the Ethernet frames into at least one optical network frame and transmit the optical network frames over an optical supervisory channel of the optical transport network (column 5 lines 32-41; e.g. “spare channel” in column 6 lines 13-26).

Regarding claim 10, Richards teaches that the first network element is adapted to receive the optical network frames over the optical supervisory channel (e.g. “spare channel” in column 6 lines 13-26) from the second network element and to extract the Ethernet frames from the optical network frames (inherent in the use of the Ethernet protocol in the system).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 11-20, and 22-31, 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards.

Regarding claim 7, Richards differs from the claimed invention in that Richards fails to specifically teach that the first network element is further operable to store the network performance data in a storage medium residing on the second network element and the network diagnostic device operable to retrieve the network performance data from the second network element using a file transfer protocol. However, it is clear that the network element in Richards is of the typical sort and is clearly capable of storing the performance data until the diagnostic device retrieves it. Furthermore, storage of performance data at network elements is well known in the art. One skilled in the art would have been motivated to include storage at the network

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element in order to allow the diagnostic device to develop an better understanding of the long term operational characteristics of the network element and to retrieve that information at will. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to include a storage medium at the first network element and allow the diagnostic device operable to retrieve the network performance data from the first network element using a file transfer protocol.

Regarding claims 11-20, 22-31, and 33-36, Richardson differs from the claimed invention in that Richardson fails to specifically teach the various diagnostic operations claimed. However, the diagnostic methodologies claimed are well known in the art and easily applicable to the system of Richardson. Furthermore, one skilled in the art would have been motivated to employ the various methods claimed in order to develop an overall measure of system performance based on a variety of measures. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to employ the diagnostic methodologies claimed in the system of Richardson.

### ***Response to Arguments***

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. A second look at Richards reveals that Richards, when given the broadest reasonable interpretation, meets the limitations of the claim as amended. Furthermore, and in response to applicant's argument that Richardson fails to specifically teach the various diagnostics operations performed, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agustin Bello whose telephone number is (571) 272-3026. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (571)272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB

  
**AGUSTIN BELLO**  
**PRIMARY EXAMINER**